REMARKS

Claims 1, 4-8, 10, 13, 19, 29-34, 45 and 84 are pending in the present application. Claims 1, 4-8, 10 and 13 are allowed. Claims 19, 32-34, 45 and 84 are rejected under 35 USC 102(b) and claims 29-31 are rejected under 35 USC 103(a). Applicants respectfully request reconsideration of the application, withdrawal of all rejections, and allowance of the application in view of the amendments and remarks below.

The Amendments to the Claims

Without prejudice to the Applicants' rights to present claims of equal scope in a timely filed continuing application, in order to expedite prosecution and issuance of the application, Applicant has amended claims 5, 6, 19, 30, 31 and 84. Additionally, Applicant has presented new claims 85-91. The amendments to the claims and addition of the new claims do not introduce new matter.

Claim 19 is amended to recite "heating a zone of the substrate, wherein the heated zone has a surface area less than the compound deposition area," which is supported at, e.g., page 39, line 25 to page 40, line 3 of the specification, and "increasing the size of the heated zone to progressively vaporize compound exposed to the heated zone" which is supported at, e.g., page 18, lines 21-27; page 40, line 15 to page 41, line 22 of the specification; and FIG. 20. Claim 84 has been amended to recite "heating a zone of the substrate," which is supported at, e.g., page 39, line 25 to page 40, line 3 of the specification, and "moving the heated zone with respect to the substrate to progressively vaporize compound exposed to the heated zone," which is supported at, e.g., page 40, lines 5-14 of the specification. The amendments to claims 5, 6, 30 and 31 are supported at page 4, lines 1-2 of the specification. Support for new claims 85-91 is found in the original claims and at page 25, line 29 to page 26, line 1; page 11, lines 1-2; page 20, line 12; page 25, line 29; page 9, lines 25-27; and page 23, lines 4-5 of the specification.

Applicants respectfully submit that the amendments to the claims put the case in condition for allowance. The Examiner is respectfully requested to enter the amendments to the claims and new claims and allow all claims.

The Rejection under 35 U.S.C. 102(b)

Claims 19, 32-34, 45 and 84 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Counts et al. (U.S. Patent No. 5,060,671).

As amended, independent claim 19, from which claims 32-34 and 45 depend, requires heating a zone of the substrate, wherein the heated zone has a surface area less than the compound deposition area and increasing the size of the heated zone to progressively vaporize compound exposed to the heated zone. As amended, independent claim 84 requires heating a zone of the substrate and moving the heated zone with respect to the substrate to progressively vaporize compound exposed to the heated zone. As explained below, Counts et al. does not disclose either limitation.

The flavor generating article of Counts et al. comprises "a plurality of charges of flavor generating medium, electrical means for individually heating each of the plurality of charges ... and control means for applying the electrical heating means to individually heat one of the plurality of charges." (col. 2, lines 1-7; emphasis added). Each of the charges, when heated, delivers a "puff" of the flavor-containing substance to the user. In each of the embodiments disclosed in Counts et al., one of the charges of flavor generating medium is selected, a heater is activated to heat the charge, and then the heater is deactivated until a different individual charge is selected for the next puff (col. 1, line 66; col. 11, line 68 to col. 12, line 11). Thus, the entire charge of flavor generating medium of Counts et al. is contained within the heated zone and is heated at the same time. The heated zone does not migrate, travel, increase in size, or otherwise move.

The Office Action asserts that Counts et al. teach a moving heating zone at col. 6, lines 10-18. This passage relates to an embodiment employing a cylindrical heater having a number of vanes coated with flavor generating medium, each vane representing one puff of the article. The first vane is heated by contacting the vane to a power source, but the heating zone does not move – all of the flavor generating medium coated on the vane is exposed to heat at the same time. When it is time for the next puff, a different vane is selected and heated.

Anticipation requires that "a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Industries. Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1642 (Fed. Cir. 1996), *see also* MPEP §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051

(Fed. Cir. 1987). As Counts et al. fails to disclose "heating a zone of the substrate, wherein the heated zone has a surface area less than the compound deposition area" or "increasing the size of the heated zone to progressively vaporize compound exposed to the heated zone," the reference can not be said to anticipate the method of independent claim 19, or claims 32-34 and 45, which depend therefrom. Likewise, as Counts et al. fails to disclose "heating a zone of the substrate and moving the heated zone with respect to the substrate to progressively vaporize compound exposed to the heated zone," the reference can not be said to anticipate the method of amended independent claim 84. Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C § 102(b).

New claims 85-91, which depend from independent claim 84, are not anticipated by Counts et al. for the same reasons provided with respect to claim 84.

The Rejection under 35 U.S.C. §103(a)

Claim 29 is rejected under 35 U.S.C. §103(a) as obvious over Counts et al.

Applicant respectfully disagrees in view of the amended claims and the disclosure of the prior art. Claim 29, like amended independent claim 19 from which it depends, requires heating a zone of the substrate, wherein the heated zone has a surface area less than the compound deposition area and increasing the size of the heated zone to progressively vaporize compound exposed to the heated zone. Neither of these limitations is disclosed or suggested by Counts et al.

According to the MPEP § 2143, "to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claim limitations." Obviousness cannot be established by combining teachings in the prior art, absent some teaching or suggestion in the prior art that the combination be made (*In re Stencel* 828 F. 2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987); *In re Newell* 891 F. 2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989)).

As Counts et al. fails to teach or suggest "heating a zone of the substrate and moving the heated zone with respect to the substrate to progressively vaporize compound exposed to the

heated zone," all of the elements of claim 29 are not taught or suggested by the reference. Accordingly, for at least this reason, the Office Action fails to establish a *prima facie* case of obviousness of claim 29.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as obvious over Counts et al. as applied to the claims above, and further in view of Rabinowitz et al.

Applicant respectfully disagrees in view of the amended claims and the disclosure of the prior art. Claims 30 and 31, like amended independent claim 19 from which the depend, require heating a zone of the substrate, wherein the heated zone has a surface area less than the compound deposition area and increasing the size of the heated zone to progressively vaporize compound exposed to the heated zone. Neither of these limitations is disclosed or suggested by Counts et al. or Rabinowitz et al. Accordingly, for at least this reason, the Office Action fails to establish a *prima facie* case of obviousness as each and every element of claims 30 and 31.

New claims 85-91, like amended independent claim 84, require heating a zone of the substrate and moving the heated zone with respect to the substrate to progressively vaporize compound exposed to the heated zone. Neither of these limitations is disclosed or suggested by Counts et al. or Rabinowitz et al. Thus, these claims patentably distinguish over Counts et al. and Rabinowitz et al. for at least the same reasons as claim 84.

Accordingly, and in light of the foregoing arguments, the Applicants respectfully submit that these amendments put the case in condition for allowance and request that the Examiner reconsider and withdraw all rejections based on 35 U.S.C §103.

Conclusion

Applicants appreciate the Examiner's careful and thorough review of the application and submit that the Examiner's concerns have been addressed by the amendments and remarks above. Applicants accordingly request the Examiner to withdraw all rejections and allow the application. In the event the Examiner believes a telephonic discussion would expedite allowance or help to resolve outstanding issues, prosecution of the application, then the Examiner is invited to call the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

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